REMARKS

This is a full and timely response to the outstanding final Office Action mailed September 18, 2008 (Paper No. 20080911). Upon entry of this response, claims 1-16 and 114-180 are pending in the application. In this response, claims 114, 148, and 150-151 are amended, and claims 165-180 are added. Applicant respectfully requests entry of the amendments herein and reconsideration of all pending claims.

I. Claim Objections

Claims 150-151 are objected to because of various informalities related to the preamble. Claims 150-151 are amended. Applicant respectfully submits that the objections have been overcome, and request that the objection be withdrawn.

II. Rejection of Claims 114-131 and 148-168 under 35 U.S.C. § 112, Second Paragraph

Claims 114-131 and 148-168 are rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention. Specifically, the Office Action alleges (p. 3) that claims 114-131 and 148-168 have insufficient antecedent basis for "the STT". Applicant respectfully disagrees with this rejection as applied to claims 114-131, since the preamble of independent claim 114 provides antecedent basis by reciting "[a] master set-top terminal (STT)". The preamble of independent claim 148 is amended to overcome the rejection by reciting "[a] computer readable medium encoded with computer executable instructions operable in a set-top terminal (STT)". Applicant respectfully requests that the rejection be withdrawn.

III. Rejection of Claims 148-164 under 35 U.S.C. § 101

Claims 148-164 are rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. The Office Action alleges that:

> Claims 148-164 recites "a computer readable medium encoded with computer executable instructions operable to:" does not define structural and functional relationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus non-statutory (see M.P.E.P 2106.01).
> (Office Action, p. 3)

The Office Action thus appears to contend that the preamble of claims 148-164 is *per se* improper. Applicant respectfully disagrees. The Office Action has provided no legal basis for this *per se* requirement. Neither the Federal Circuit nor the BPAI has adopted a rule indicating that specific preambles are acceptable under §101 while others are not. Therefore the rejection is legally deficient and should be withdrawn.

Furthermore, Applicant submits that claims 148-164 does comply with §101 since it recites functional descriptive material recorded on a machine-readable medium. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)(discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and In re *Warmerdam*, 33 F.3d *1354, 1360-61, 31 USPQ2d *1754, 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Therefore, the rejection should be withdrawn.

IV. Rejection of Claims 1-16 under 35 U.S.C. §103

Claims 1-16 are rejected under §103(a) as allegedly obvious over *Ellis et al.* (U.S. Pub. No. 2002/0028208, hereinafter "*E208*") in view of *Miura et al.* (U.S. Pat. No. 6,996,837) and *Rakib et al.* (U.S. Pub. No. 2004/0172658) and *Brookes et al.* (U.S. Pat. No. 7,114,174). Applicant respectfully traverses this rejection. It is well established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest (either

implicitly or explicitly) all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

A. Independent Claim 1

Claim 1 is amended to recite "an encoder supporting a plurality of encoding formats and…configured to automatically change the parameter such that the quality of the encoded signal is improved wherein the parameter change is responsive to a change in capability of the encoder to encode at the improved quality". Applicant respectfully submits that the proposed combination fails to teach, disclose or suggest at least this feature.

The Office Action contends (p. 12 and p. 22) that Col. 9 line 20 to Col. 10 line 67 of *Brookes et al.* teaches an encoder supporting multiple encoding formats and which changes the encoding quality parameter such that quality of the encoded signal is improved. Applicant agrees that this portion of *Brookes et al.* describes a data acquisition block 400 which includes transcoder 420 and a control block 450, where the transcoder 420 controls encoding quality according to "bandwidth parameters" provided to it by control block 450. (Col. 9, lines 44-65.) This portion of *Brookes et al.* also states that "as the desired output bandwidth is determined and processed, the bandwidth and format of the output stream will be adjusted to the desired parameters" (Col. 10, lines 60-65). In discussing how the desired output bandwidth is determined, this portion of *Brookes et al.* also states that the parameters are "typically derived from the requesting device". Thus, in the system of *Brookes et al.*, the encoding quality is adjusted based on information provided by the requester. In contrast, amended claim 1 recites that the change in the parameter describing quality of the encoded signal "is responsive to a change in capability of the encoder to encode at the improved quality".

Applicant respectfully submits that none of the other references (*E208*, *Miura et al.*, and *Rakib et al.*) disclose, teach, or suggest the above-described feature. Accordingly, the proposed

combination of *E208* in view of *Miura et al.*, *Rakib et al.*, and *Brookes et al.* does not teach at least the above-described features recited in claim 1. Therefore, a *prima facie* case establishing an obviousness rejection has not been made, and the rejection should be withdrawn.

B. Dependent Claims 2-16

Since independent claim 1 is allowable, Applicant respectfully submits that claims 2-16 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant respectfully requests that the rejection of claims 2-16 be withdrawn.

V. Rejection of Claims 114-164 under 35 U.S.C. §103

Claims 114-164 are rejected under §103(a) as allegedly obvious over *Ellis et al.* (U.S. Pub. No. 2002/0028208) in view of *Brookes et al.* (7,114,174). Applicant respectfully traverses this rejection. It is well established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest (either implicitly or explicitly) all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

A. Independent Claim 114

Claim 114 is amended to recite “an encoder supporting a plurality of encoding formats and…configured to automatically change the parameter such that the quality of the encoded signal is improved wherein the parameter change is responsive to a change in capability of the encoder to encode at the improved quality”. Applicant respectfully submits that the proposed combination fails to teach, disclose or suggest at least this feature.

The Office Action contends (p. 12 and p. 22) that Col. 9 line 20 to Col. 10 line 67 of *Brookes et al.* teaches an encoder supporting multiple encoding formats and which changes the

encoding quality parameter such that quality of the encoded signal is improved. Applicant agrees that this portion of *Brookes et al.* describes a data acquisition block 400 which includes transcoder 420 and a control block 450, where the transcoder 420 controls encoding quality according to "bandwidth parameters" provided to it by control block 450. (Col. 9, lines 44-65.) This portion of *Brookes et al.* also states that "as the desired output bandwidth is determined and processed, the bandwidth and format of the output stream will be adjusted to the desired parameters" (Col. 10, lines 60-65). In discussing how the desired output bandwidth is determined, this portion of *Brookes et al.* also states that the parameters are "typically derived from the requesting device". Thus, in the system of *Brookes et al.*, the encoding quality is adjusted based on information provided by the requester. In contrast, amended claim 114 recites that the change in the parameter describing quality of the encoded signal "is responsive to a change in capability of the encoder to encode at the improved quality".

The Office Action acknowledges (p. 21) that *E208* does not disclose the above-described feature. Accordingly, the proposed combination of *E208* in view of *Brookes et al.* does not teach at least the above-described features recited in claim 114. Therefore, a *prima facie* case establishing an obviousness rejection has not been made, and the rejection should be withdrawn.

B. Independent Claims 131 and 148

Claim 131 is amended to recite "automatically changing the parameter to improve the quality of the encoded signal, responsive to a change in capability to encode at the improved quality". Claim 148 is amended to recite "automatically change the parameter such that the quality of the encoded signal is improved, responsive to a change in capability to encode at the improved quality". Applicant respectfully submits that the proposed combination fails to teach, disclose or suggest at least these features.

The Office Action contends (p. 12 and p. 22) that Col. 9 line 20 to Col. 10 line 67 of *Brookes et al.* teaches an encoder supporting multiple encoding formats and which changes the encoding quality parameter such that quality of the encoded signal is improved. Applicant agrees that this portion of *Brookes et al.* describes a data acquisition block 400 which includes transcoder 420 and a control block 450, where the transcoder 420 controls encoding quality according to "bandwidth parameters" provided to it by control block 450. (Col. 9, lines 44-65.) This portion of *Brookes et al.* also states that "as the desired output bandwidth is determined and processed, the bandwidth and format of the output stream will be adjusted to the desired parameters" (Col. 10, lines 60-65). In discussing how the desired output bandwidth is determined, this portion of *Brookes et al.* also states that the parameters are "typically derived from the requesting device". Thus, in the system of *Brookes et al.*, the encoding quality is adjusted based on information provided by the requester. In contrast, amended claims 131 and 148 recites that the change in the parameter describing quality of the encoded signal "is responsive to a change in capability of the encoder to encode at the improved quality".

The Office Action acknowledges (p. 21) that *E208* does not disclose the above-described feature. Accordingly, the proposed combination of *E208* in view of *Brookes et al.* does not teach at least the above-described features recited in claims 131 and 148. Therefore, a *prima facie* case establishing an obviousness rejection has not been made, and the rejection should be withdrawn.

C. Dependent Claims 115-130, 132-147, and 149-164

Since independent claims 114, 131, and 148 are allowable, Applicant respectfully submits that claims 115-130, 132-147, and 149-164 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant respectfully requests that the rejection of claims 115-130, 132-147, and 149-164 be withdrawn.

VI. Newly Added Claims

Applicant submits that new claims 165-180 are allowable over the cited references, for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant requests the Examiner to enter and allow the above new claims.

CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 1-16 and 114-180 be allowed to issue. Any statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

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